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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,130	03/07/2000	Robert Arathoon	P1099R2	1353
25213	7590	05/08/2007	EXAMINER	
HELLER EHRMAN LLP			HOLLERAN, ANNE L	
275 MIDDLEFIELD ROAD			ART UNIT	
MENLO PARK, CA 94025-3506			PAPER NUMBER	
			1643	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 09/520,130	Applicant(s) ARATHOON ET AL.	
	Examiner Anne L. Holleran	Art Unit 1643	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: _____
Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


 LARRY R. HELMS, Ph.D.
 SUPERVISORY PATENT EXAMINER

Continuation of 3. NOTE: The new issues raised are that the amendments to claim 47 would cause the claims to be rejected under 35 USC 112, 2nd paragraph, because of the phrases "first light chain monomer" and "another of the first light chain monomers". It is not clear what structural feature is delineated by the inclusion of the term monomer, and furthermore, it is not clear how use of the term "monomer" would change the scope of the claim to exclude scFv constructs, because the claims continue to recite "first polypeptide" and a "second polypeptide". Additionally, the amendment to claim 47 appears to introduce new matter into the specification, because there does not appear to be support in the specification for a first light chain monomer. While the specification appears to provide support for bispecific antibodies that have two heavy and two light chains (where the two light chains are identical), the claims are broader than this and include within their scope diabody-type constructs.

Continuation of 5. Applicant's reply has overcome the following rejection(s): If entered, the reply would obviate the rejection of claim 53 under 35 USC 112, 2nd paragraph, in view of the proposed cancellation of claim 53..

Continuation of 13. Other: Continuation of 13. Other: Claims 47-63 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30-38, 40-43, 45-51 and 53-55 of copending application no. 09/373,403. Claims 47-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45-82 of application no. 10/143,437, now US Patent 7,183,076. Applicants' remarks concerning holding these rejections in abeyance until the indication of allowable subject matter is noted. Applicants' remarks concerning copending applications 11/537,195, 11/536,951, 11/608,673 and 11/536,439 are acknowledged.

Additionally, for clarification of the record, the restriction requirement between groups I-VII and the election of species requirement of the paper mailed out 7/5/2001 in this application, is hereby withdrawn.

If entered, claims 47 and 52 would remain rejected under 35 USC 102(b) for the reasons of record. The amendment to claim 47 fails to obviate the rejection over Nissim, because the claims continue to include within their scope diabody-type scFv constructs. The amendment of claim 47 to include the phrase "the first polypeptide comprises in turn two polypeptides wherein one is a first heavy chain [...] and one is a first light chain monomer..." could reasonably be interpreted to include a fusion protein having two subunits, a heavy chain variable domain and a light chain variable domain, and thus would be a single peptide backbone that comprises both the heavy chain variable domain and light chain variable domain. If entered, claims 47, 48 50 and 52 would remain rejected under 35 USC 102(b) as being anticipated by de Kruif for the reasons of record. If entered, claims 47-49, 52, 54, 55, 58-61 and 63 would remain rejected under 35 USC 103(a) as being unpatentable over de Kruif as evidenced by Merchant in view of Ridgeway for the reasons of record. If entered, claims 47-52 and 54-63 would remain rejected under 35 USC 103(a) over de Kruif as evidenced by Merchant in view of Ridgeway and further in view of Hu for the reasons of record.